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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/056,857	01/24/2002	Raymond G. Wardell	BLD920010015	3785

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EXAMINER

KANG, ROBERT N

ART UNIT	PAPER NUMBER
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2625

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/07/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/056,857

Applicant(s)

WARDELL ET AL.

Examiner

Robert N. Kang

Art Unit

2625



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 December 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

Response to Arguments

1. Applicant's arguments filed 12/11/2006 have been fully considered but they are not persuasive.
2. Applicant has amended to include the limitation of "generating a second identifier identified from the resource from the source data." This limitation is still met by Wang, as the character information 600 requires knowledge of which font is being utilized in the document, or source data. Thus, the character information is generated at least in part from the source data.
3. Applicant has amended to include the step of "associating the second identifier with the first identifier." Under the broadest reasonable limitation, Wang's invention still teaches this feature. As the driver generates the bitmap rendering information 600, it is utilized by the printer *only for the particular fonts* of the print job. I.e., a print job may include several fonts, some which are printer resident and some which require external glyph data. Thus, the printer must determine which characters in the document are to be rendered using the printer resident font and which characters are to be rendered with the glyph data. Thus, there is necessarily an *association* between the font designator in the source document (first identifier) and the font rendering data (second identifier).
4. Applicant states on page 14, paragraph 4, "the Office Action appears to indicate that it is commonly known in the art that such features would emanate application software such as a word processor." The examiner does not understand what it means

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for a feature to "emanate application software" and therefore cannot provide documentary evidence of this assertion.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 1-30 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. TC 2600 has issued a stricter interpretation of the interim guidelines regarding 35 U.S.C. § 101. Because the invention is directed to an apparatus which comprises *only software* with minimal hardware, executing a method of *data manipulation that does not occur outside of memory*, there is not a real, concrete, and tangible result. The specification itself claims a "memory structure," which is nonstatutory material as well. Examiner points to paragraph 0020, wherein the actual invention claimed is merely software manipulating data in memory. The Office's position on apparatus/method/computer readable medium claims of this type is that the claims are directed towards non-statutory subject matter.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-9, 11-19, and 21-29 are rejected under 35 U.S.C. 102(e) as being anticipated by Wang (US-PAT 2004/0225773).

Regarding claim 1, Wang discloses a method implemented by a driver program 420, "communicating between application program 410 and the printer 430," (paragraph 0038). The application program runs on a computer system 100, where the driver program 420 "receives document 135 from the application program 410. Document 135 may include one or more character encoding specifications 445, such as ASCII, and one or more font identifiers 447 within each character encoding specification," (paragraph 0038). Thus, the method disclosed by Wang includes a step of "receiving source data."

Broadly defined, the "source data" is the actual document text and position information created by the user with the application software (such as a word processing application). The application as commonly known in the art, creates an output file to be printed by the device driver. This, broadly defined, comprises the step of "generating a job ticket."

Because the print file, or "job ticket," comprises document including a resource, a specific font and its individual characters, and the positioning of each character on the page, Wang's invention includes a step of "receiving a job ticket generated from the source data, the job ticket having a first identifier identifying a resource of the document and layout information describing a layout of the resource in the document," as required by limitation 2.

Wang discloses in paragraphs 0039-0040, "within the device driver program 420, method 130 determines whether a font identifier 447 defines a printer resident font... If font identifier 447 does not identify a printer resident font, bitmap character rendering information 600 is generated in method 130 and sent to printer 430. This bitmap character rendering information may include a single or multiple byte character identifier 610... Bitmap data 670 is also transmitted to the printer with the bitmap character rendering information 600, and provides a bitmap version of the character image directly to the printer, thus making the rendering of the character on the printer or output device independent of the issue whether the specified font is resident on the output device." Therefore, Wang's invention includes the step of "generating a second identifier associated with the resource," since the bitmap character rendering information 600 (including individual character identifiers 610) is generated and associated with actual bitmap data 670, which is essentially the "resource." Additionally, the printer or output device utilizes these identifiers 610 to render characters and as such the "second identifier[s] [are] locally recognizable by a printing device."

Wang's invention stores fonts within the driver program 420, which resides in either memory 111 or memory 184, depending on the embodiment. In either scenario, the second identifiers are "stored remotely from the printing device," as well as locally within the printing device after transmission of the font.

With regards to limitation 5, Wang states in paragraph 0035, "the retrieved bitmap and data and glyph information, as well as position information for drawing the bitmap, is then transmitted to the printer in procedure 340. The bitmap data is used to

generate an image for display on a printer in procedure 350." This comprises "storing the resource locally to the printing device," and "printing the stored resource according to the layout information."

Finally, regarding the preamble, Wang's invention pertains to any file to be printed with font data, which includes impositioned documents.

Thus the limitations of claim 1 are anticipated by Wang. Examiner asserts that claims 11 and 21 are merely the counterpart apparatus and computer readable medium claims of claim 1, and as such are anticipated by Wang as well.

Regarding claims 2, 12, and 22, Wang's driver program 420 "receives the source data," encapsulated in the job ticket, and stores the font data. Therefore, the driver program 420 is a "print optimizer." Additionally, Wang's application program 410 comprises an impositioning module, since it determines the resources and layout of the job. Thus the "job ticket is generated by an impositioning module."

In regards to claims 3, 13, and 23, Wang states in paragraph 0039, "within device driver program 420, method 130 determines whether a font identifier 447 defines a printer resident font. If so, printer resident character rendering information 500 shown in FIG. 5 is generated using method 13 and sent to printer 430." Thus the second identifier, as defined by the interpretation of claim 1, the non-resident character rendering information 600, is not generated because the font is already resident on the printer, and therefore not "new."

With regards to claims 4, 14, and 24, Wang's printer driver 420 converts the document 135 into device readable document data 450. Thus, the bitmap data of a given font is also converted into a format which may be utilized by the printer. Therefore, Wang's invention anticipates "converting the resource into a a printing device-renderable form if the resource is not in the printing device-renderable form."

In regards to claims 5, 15, and 25, Wang discloses in paragraph 0037, "the output device is a printer and the arbitrary font data is used within the PostScript page description language." Therefore, the device renderable form is "compliant with a page description language."

With regards to claims 6, 16, and 26, the font data of Wang is initially stored in the computer 100, but eventually transmitted to the output device 117. Therefore, it is "stored in a memory of the printing device."

In regards to claims 7, 17, and 27, the method 130 of Wang is executed only if the font is not resident on the printer, and thus "the resource is stored locally to the printing device only if the resource is not already stored locally to the printing device."

Regarding claims 8, 18, and 28, Wang's invention operates on a job-by-job basis. After a first job utilizing a nonresident font is printed, by virtue of the invention, the

nonresident font has been stored in the printer and becomes a resident font. Therefore, a subsequent job utilizing the same font would execute in the same manner as disclosed with a resident font. "this comprises receiving a second job ticket having the first identifier and second layout information describing a second layout of the resource in the document."

In such a case, the font data, being detected as resident, is sent with a resident font identifier 500 and printed with the same font. This, broadly defined, comprises "transforming the first identifier into the second identifier," and "printing the stored resource according to the second layout information."

With regards to claims 9, 19, and 29, requiring that the "impositioned document comprises variable data, and the method further comprises the steps of augmenting the job ticket with the variable data," Wang's invention, broadly defined, adjusts the layout of the font in two manners, one, the position of each individual character, and two, the sequencing of each individual character. Under the broadest possible interpretation, both the layout and the sequence are "variable data." Thus, any alterations of the sequence, whether by manually typing data or importing data (time/date, name, etc.) via the application may be considered "augmenting the job ticket with the variable data." Thus Wang's invention anticipates the features of claims 9, 19, and 29.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 10, 20, and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wang (US-PAT 2004/0225773) in view of Dorfman (US-PAT 5,960,164).

Wang meets the limitations of claims, 9, 19, and 29, upon which claims 10, 20, and 30 respectively depend.

Wang does not disclose a method of augmenting job tickets with variable data wherein the source data has variable tag data, the first identifier (font type) is associated with the variable tag data, replacing variable data tags with a variable data or a reference to the variable data, and augmenting the job ticket with the variable data or the reference to the variable data.

Dorfman discloses in column 4, lines 29-53, "the method comprises the following steps... (b) identifying the variable data fields associated with each document ... (c) defining the fonts and characters for variable data at the time individual jobs are built... (h1) converting data to be supplied to the system into resolution specific bitmaps. (h2) Imposing the data from the resolution specific bitmaps onto a specific signature. And (h3) positioning and rotating variable text fields as each signature is built." Thus, step (b) comprises "accepting source data having variable tag data," step (c) teaches

associating the font type (or "first identifier") with the variable tag data, and finally steps (h1)-(h3) replaces the variable data tags with the actual signature or "variable data."

Wang and Dorfman are combinable because the two inventions pertain to the printing of various print jobs and print preprocessing. Wang's invention may be utilized with ANY software application which outputs a print job or "job ticket" and thus may be easily combined with Dorfman's invention.

Therefore, it would have been obvious at the time of invention to one of normal skill in the art to include in Wang's application 410 a system for including variable data as taught by Dorfman.

The motivation of this modification would be to allow an application for the imposition of various documents with variable text data to print to a printer with any font, wherein the font may be automatically downloaded and rendered even if the font is not resident on the print device.

Thus it would have been obvious at the time of invention to combine Wang and Dorfman to obtain the invention as disclosed in claims 10, 20, and 30.

Conclusion

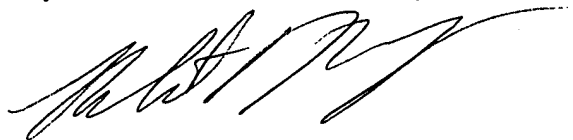
This Office Action is Non-Final.

Examiner would like to inform the applicant that art unit 2622 has been re-designated as art unit 2625 due to organizational restructuring with the Patent & Trademark Office.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert N. Kang whose telephone number is 571-272-0593. The examiner can normally be reached on M-F 9-6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Twyler M. Lamb can be reached on (571)272-7406. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



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